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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,534	03/01/2004	Robert K. Holzwarth	H10522/JDP	2751
1333 7590 01/23/2009 EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER, NY 14650-2201			EXAMINER RODRIGUEZ, LENNIN R	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 01/23/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/790,534

**Applicant(s)**

HOLZWARTH ET AL.

**Examiner**

LENNIN R. RODRIGUEZ

**Art Unit**

2625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the appeal brief filed on 6/30/2008, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

***Response to Arguments***

2. Applicant's arguments, see Appeal Brief, filed on 10/23/2008, with respect to the rejection(s) of claim(s) 23-45 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Laverty et al. (US 6,429,947) in view of Schorr et al. (US 6,608,697).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 23-24, 26-35 and 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kremer et al. (US Application 2001/0043365) in view of Duniho (US 5,835,690).

(1) regarding claims 23 and 34:

Kremer '365 discloses a printing system for placing content within an electronic document to be printed (Fig. 1), the system comprising:

a job preparation station for preparing the document in a first printer ready file format (paragraph [0026], lines 3-8) wherein each page to receive a page number when printed is provided with a flag, tag or marker (paragraph [0016], lines 1-5), said station including a computer having a memory (paragraph [0029], lines 1-2 and 23-31); and

said computer having a routine and operative to employ the routine to calculate page numbers (paragraph [0027], lines 3-6, where numbers are being applied and paragraph [0030], lines 4-9) and to modify the document into a second printer ready file format (paragraph [0030], lines 38-41, where after the alterations the document is formatted again) wherein different page numbers are thereby associated with the pages

to receive page numbers (paragraph [0027], lines 3-6, where numbers are being applied to the respective pages and paragraph [0030], lines 4-9).

Kremer '365 discloses all the subject matter as described above except said job preparation station including an input device for a user to input the flag, tag or marker in association with each said page to receive a page number;

However, Duniho '690 teaches said job preparation station including an input device for a user to input the flag, tag or marker in association with each said page to receive a page number (column 8, lines 35-44, where the user can add a header or footer capable of holding the page number);

Having a system of Kremer '365 reference and then given the well-established teaching of Duniho '690 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printing system of Kremer '365 to include said job preparation station including an input device for a user to input the flag, tag or marker in association with each said page to receive a page number as taught by Duniho '690 because in this way the system becomes user-friendlier by allowing user manipulation of page number displaying.

(2) regarding claims 24 and 35:

Kremer '365 further discloses wherein the first printer ready file format is as a PDF document and the second printer ready file format is as a PDF document (paragraph [0034], lines 8-10).

(3) regarding claims 26 and 37:

Kremer '365 further discloses wherein the pages of the document in the second printer ready format retain the flag, tag or marker in association with each said page so as to identify that page numbering by the computer operating the routine was used to calculate the different page numbers (paragraph [0027], lines 3-6, where numbers are being applied and paragraph [0030], lines 4-9).

Kremer '365 discloses all the subject matter as described above except the flag, tag or marker able to receive a page number;

However, Duniho '690 teaches the flag, tag or marker able to receive a page number (column 8, lines 35-44, where the user can add a header or footer capable of holding the page number);

Having a system of Kremer '365 reference and then given the well-established teaching of Duniho '690 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printing system of Kremer '365 to include the flag, tag or marker able to receive a page number as taught by Duniho '690 because in this way the system becomes user-friendlier by allowing user manipulation of page number displaying.

(4) regarding claims 27 and 38:

Kremer '365 further discloses wherein a flag, tag or marker is associated with one or more pages of the electronic document in the first printer ready file format to identify said one more pages as receiving a watermark (paragraph [0030], lines 30-32).

(5) regarding claims 28 and 39:

Kremer '365 further discloses wherein the job preparation station includes a display for reviewing thumbnails of all pages within the document and the user input device allows the user to select those pages that are not to receive a page number and those pages not to receive a page number are provided with a flag, tag or marker (paragraph [0044], lines 32-54, where the visual representations are being interpreted as thumbnails (according to the definition of a thumbnail)).

(6) regarding claims 29 and 40:

Kremer '365 further discloses wherein in a preview mode the thumbnails do not have page numbers displayed (paragraph [0051], where is not until the output of the document that the page numbers are being printed allowing for rearranging of the pages within the document).

(7) regarding claims 30 and 41:

Kremer '365 further discloses wherein pages within the document in a first printer ready file format may be moved around the document without introducing page-numbering conflicts (paragraph [0051], where is not until the output of the document that the page numbers are being printed allowing for rearranging of the pages within the document).

(8) regarding claims 31 and 42:

Kremer '365 further discloses wherein pages within the document in a first printer ready file format may be moved to a different document without introducing page-numbering conflicts (paragraph [0051], where is not until the output of the document

that the page numbers are being printed allowing for rearranging of the pages within the document or different documents).

(9) regarding claims 32 and 43:

Kremer '365 further discloses wherein a subset of pages of the document to be printed are to be printed on tab stock and at least some pages of the electronic document to be printed on tab stock (paragraph [0016], tab set).

Kremer '365 discloses all the subject matter as described above except a tab stock that have associated therewith a respective flag, tag or marker to identify such pages as to have a respective page number printed thereon;

However, Duniho '690 teaches a tab stock that have associated therewith a respective flag, tag or marker to identify such pages as to have a respective page number printed thereon (column 8, lines 35-44, where the user can add a header or footer capable of holding the page number);

Having a system of Kremer '365 reference and then given the well-established teaching of Duniho '690 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printing system of Kremer '365 to include a tab stock that have associated therewith a respective flag, tag or marker to identify such pages as to have a respective page number printed thereon as taught by Duniho '690 because in this way the system becomes user-friendlier by allowing user manipulation of page number displaying.

(10) regarding claims 33 and 44:



Kremer '365 further discloses wherein the document to be printed includes pages that are to be printed as duplex pages and other pages to be printed as simplex pages (paragraph [0045], lines 8-10).

5. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kremer et al. (US 2001/0043365) and Duniho (US 5,835,690) in view of Krist et al. (EP 0 478 351 A2).

Kremer '365 discloses all the subject matter as described above except wherein in the electronic document page numbers are removed from certain pages and the electronic document is reprocessed by recalculating page numbers.

However, Krist '351 teaches wherein in the electronic document page numbers are removed from certain pages (page 7, lines 49-51, where an user can remove the page numbers from certain pages) and the electronic document is reprocessed by recalculating page numbers (page 7, lines 49-56, where the system automatically skips putting number on specified pages and renumber the ones left).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein in the electronic document page numbers are removed from certain pages and the electronic document is reprocessed by recalculating page numbers as taught by Krist '351, in the system of Kremer '365. With this the system allows the users to have more flexibility when printing a print job, since maybe not all the pages need to be numbered (page 7, line 49), thus becoming user friendlier.

6. Claims 25 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kremer et al. (US 2001/0043365) and Duniho (US 5,835,690) in view of Ghobrial et al. (US 2003/0079214).

Kremer '365 further discloses that all of the collected documents are converted to a ready for printer format, preferably a Portable Document Format (paragraph [0034], lines 8-10) and formatting and other modifications to the document can be globally applied to the entire document, such as a shifted margin or may be applied only to select pages. Such alterations to the document are known as document/page features or attributes. Further, these alterations are also known as document or page exceptions since they typically override specific instances of the original document formatting as set by the customer (paragraph [0030], lines 33-41).

Kremer '365 discloses all the subject matter as described above except wherein the pages of the document in the first printer ready file format are portable and pages of the document in the second printer ready file format are unportable.

However, Ghobrial '214 teaches wherein the pages of the document in the first printer ready file format are portable and pages of the document in the second printer ready file format are unportable (paragraph [0008], where after compilation the pages are no longer portable).

Having a system of Kremer '365 and then given the well-established teaching of Ghobrial '214, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the printing system of Kremer '365 to include that the pages of the document in the first printer ready file format are portable and

pages of the document in the second printer ready file format are unportable as taught by Ghobrial '214 since doing so the documents can be made more system specific thus allowing for system related attributes to be applied.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN R. RODRIGUEZ whose telephone number is (571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/

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Supervisory Patent Examiner, Art Unit 2625

/Lennin R Rodriguez/  
Examiner, Art Unit 2625